

REMARKS

Summary of Office Action

Claims 13-15, 19, 21, and 27-32 were pending in the above-identified patent application.

The Examiner has alleged that claims 28-32 are directed to an invention that is independent or distinct from the invention originally claimed and has withdrawn claims 28-32 from consideration.

The Examiner has objected to claim 27 under 37 C.F.R. § 1.75(c) as being of improper dependent form.

The Examiner has rejected claims 13, 19, and 27 under 35 U.S.C. § 102(b) as being anticipated by Beaudry PCT Patent Publication No. WO 97/42918 ("Beaudry").

The Examiner has rejected claims 13, 19, and 27 under 35 U.S.C. § 102(b) as being anticipated by Ness U.S. Patent No. 4,133,307 ("Ness").

The Examiner has rejected claims 14, 15, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Beaudry.

Summary of the Reply

Applicant has amended claims 13 and 27 to more particularly define the claimed invention.

Applicant has added new claims 33-39. No new matter has been added by these new claims and they are fully supported by the originally filed application. For example, see FIG. 3. Additional support can be found throughout the application.

The Examiner's objection and rejections are respectfully traversed.

Telephonic Interview Summary

On November 25, 2008, and December 30, 2008, a telephonic interview took place between the Examiner and the undersigned. The undersigned wishes to thank the Examiner for the courtesies extended during the telephonic interviews.

Generally, the Examiner and the undersigned discussed applicant's claimed feature of a strip of material that is "crescent shaped." Applicant argued that "crescent shaped" is directed to the actual device structure of applicant's claimed invention. In contrast, the Beaudry and Ness devices have an actual structure that is straight in shape (See, e.g., Beaudry, FIG. 18 and Ness, FIG. 1). The Examiner indicated that he found applicant's arguments persuasive but would like to conduct another prior art search before concluding that the claims were patentable. Detailed arguments in support of applicant's position are presented below.

The Examiner and the undersigned also discussed new, independent claim 33. However, the Examiner did not take any position regarding new, independent claim 33.

Applicant's Reply to the Election Requirement

The Examiner alleged that claims 28-32, newly added in applicant's Reply to Office Action dated April 14, 2008, are "directed to an invention that is independent or distinct from the invention originally claimed" (Office Action, page 2). In particular, the Examiner contended that claims 28-32 were independent or distinct since "method steps had not been previously searched or addressed" (Office Action, page 2). The Examiner constructively elected claims 13-15, 19, 21, and 27 by original presentation for prosecution on the merits and,

accordingly, withdrew claims 28-32 from consideration as being directed to a non-elected invention.

Applicant respectfully traverses the restriction requirement and constructive election. The claims of an application may only be restricted when those claims "are either independent or distinct" from the other claims of the application (MPEP § 803). Applicant's independent claims 28 and 13 are directed to, respectively, a method for "relieving discomfort caused by swollen tissue ailments" and an apparatus for practicing this method. A process and an apparatus for its practice are not independent inventions (MPEP § 802.01 Section II). Accordingly, applicant's newly added claims 28-32 are not independent from claim 13-15, 19, 21, and 27.

Furthermore, applicant respectfully submits that newly added claims 28-32 are not distinct from claim 13-15, 19, 21, and 27. A process and apparatus for its practice are only distinct inventions if it can be shown that (A) the process as claimed can be practiced by a different apparatus or by hand; or (B) the apparatus as claimed can be used to practice another materially different process (MPEP § 806.05(e)). Applicant respectfully submits that neither (A) nor (B) can be shown for applicant's independent claims 13 and 28. Additionally, the burden is on the Examiner to provide these "reasonable examples that recite material differences" or a restriction requirement should be withdrawn (MPEP § 806.05(e)). The Examiner has not provided these examples.

For at least these reasons, applicant respectfully submits that claims 28-32 are neither independent nor distinct from claims 13-15, 19, 21, and 27. Accordingly, applicant respectfully requests that the restriction requirement be

withdrawn, and that claims 28-32 be rejoined and examined along with the other pending claims.

Applicant's Reply to the Claim Objection

The Examiner objected to claim 27 under 37 C.F.R. § 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant respectfully traverses this objection.

Applicant's dependent claim 27, as amended, is directed to an apparatus where "said first and second ends are operable to be respectively applied to said person's buttock and hip." Applicant respectfully submits that dependent claim 17 thus limits the subject matter of independent claim 13 by further defining a structure that can apply one end to a buttock and one end to a hip. Applicant notes that a device such as the Beaudry device is incapable of applying one end to a person's buttock and one end to a person's hip since the device's structure is too small to physically reach this distance (See, e.g., Beaudry, FIG. 26).

For at least the above reason, applicant respectfully submits that claim 27 is of proper dependent form and requests that this claim objection be withdrawn.

Applicant's Reply to the 35 U.S.C. § 102(b) Rejection

The Examiner rejected claims 13, 19, and 27 under 35 U.S.C. § 102(b) as being anticipated by Beaudry. The Examiner also rejected claims 13, 19, and 27 under 35 U.S.C. § 102(b) as being anticipated by Ness. Applicant respectfully traverses these rejections.

Applicant's invention, as defined by independent claim 13, is directed to a strip of material that is operable to

separate swollen tissue from non-swollen tissue. The strip of material is crescent shaped. For example, a top view of applicant's claimed invention follows that of a crescent-shaped line (See, e.g., applicant's FIG. 3). In direct contrast, Beaudry and Ness are both directed to devices that are straight in shape. For example, a top-view of the Beaudry device follows that of a straight line (See, e.g., Beaudry, FIG. 19). Additionally, the Ness device is encompassed by a "rectangular transparent tube" that clearly defines the rectangular (i.e., straight) shape of the device (Beaudry, column 2, lines 36-38 and FIG. 1).

In support of the rejection of independent claim 13, the Examiner alleged that the Beaudry device is a "flexible strip . . . capable of assuming the shape of a crescent" and that the Ness device "when applied around a users leg is interpreted as a crescent" (Office Action, page 2). Thus, the Examiner seems to be equating a change in a device's position with the device's actual structure. However, regardless of whether or not the Beaudry or Ness device can be bent and twisted to assume various positions, the actual structure of these devices remains straight in form. Indeed, in order to force the actual structure of the Ness or Beaudry device into a crescent shape, they would need to be torn, cut, or otherwise destroyed.

For at least the foregoing reason, applicant respectfully submits that independent claim 13, and any claims depending therefrom, are patentable over Beaudry and Ness, whether taken alone or in combination. Accordingly, applicant respectfully requests that the 35 U.S.C. § 102(b) rejections of claims 13, 19, and 27 be withdrawn.

Applicant's Reply to the 35 U.S.C. § 103(a) Rejection

The Examiner rejected claims 14, 15, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Beaudry. The Examiner's rejection is respectfully traversed.

Claims 14, 15, and 21 depend from independent claim 13. As shown above, independent claim 13 is patentable. Accordingly, applicant respectfully submits that dependent claims 14, 15, and 21 are patentable at least because each of these claims depends from a patentable base claim.

Applicant's New Claims

Applicant has added new independent claim 33 and new dependent claims 34-39. The new claims are fully supported and justified by applicant's originally-filed specification and drawings and no new subject matter has been added. For example, see applicant's FIG. 3.

Applicant's invention, as defined by independent claim 33, is directed to a strip of material that is crescent shaped and that has "a tab, wherein the tab is located on at least one of the first end and the second end" of the strip. For at least the reasons discussed above in relation to independent claim 13, the new claims contain subject matter that is allowable over Beaudry and Ness. In addition, applicant finds no disclosure of "a tab" in either Beaudry or Ness.

Conclusion

For at least the reasons set forth above, applicant respectfully submits that this application is in condition for allowance. Reconsideration and prompt allowance are respectfully requested.

Respectfully submitted,

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